

Serial No. 10/013,056
Filed: October 30, 2001

REMARKS

Claims 1-6 were pending in the subject application.

Claims 1, 2 and 6 are amended.

Claim 3 is canceled without prejudice or disclaimer of subject matter.

Accordingly, claims 1, 2 and 4-6 are pending in the subject application.

The claims are amended to more clearly define the subject matter of the present invention. No new matter added.

Applicants request reconsideration of the pending claims in light of the above claim amendments taken along with the following remarks.

Priority

Applicants thank the Examiner for her reminder that a claim for foreign priority must be made in this application. Applicants respectfully submit that such claim for foreign priority was made at the time of filing the application in the application data sheet. This priority was also claimed when the declaration was filed in response to the notice of missing parts. Further, priority under 35 USC § 119(a)-(d) is perfected by Applicants' submission of a certified copy of the priority document in the parent application, serial number 09/453,195. Moreover, Applicants note that the filing receipt currently shows Applicants' claim to priority under 35 USC § 119(a)-(d).

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For the above reasons, Applicants believe that foreign priority under 35 USC § 119(a)-(d) has been established and perfected. Applicants urge the Examiner to notify the undersigned with any specific issues concerning foreign priority in the instant application.

Claim Rejections - 35 USC § 101

The Examiner rejects claims 1-3 as being directed to non-statutory subject matter. Specifically, the Examiner rejects the claims as encompassing products of nature.

While not acquiescing to the merits of the Examiner rejection, Applicants have amended the claims to be drawn to an isolated nucleic acid molecule. For this reason, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3 under 35 USC § 101.

Claim Rejections - 35 USC § 112

The Examiner rejects claims 1 and 2 under 35 USC § 112, second paragraph, as being indefinite. More specifically, the Examiner raises issue with the term "stringent hybridization" in claim 1, stating that such conditions are not defined. Moreover, the Examiner notes that claim 2 refers to SEQ ID NO:2 as a nucleic acid when it is a polypeptide.

Applicants respectfully submit that the amendment to claim 1 renders the rejection of claim 1 as being indefinite under 35 USC § 112, second paragraph, moot.

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Further, Applicants have amended claim 2 to refer to the nucleic acid that encodes a protein having SEQ ID NO:2.

For these reasons, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 1 and 2 under 35 USC § 112, second paragraph.

Claim Rejections – 35 USC § 102

The Examiner rejects claims 1, 3, 5 and 6 under 35 USC 102 § 102(b) as being anticipated by either Rousset et al. or DeVries et al. The Examiner urges that, because the polynucleotide of Rousset is 83% identical to instant SEQ ID NO:1 and because the polynucleotide of DeVries is 93.1% identical to SEQ ID NO:1, these polynucleotides would be identified by stringent hybridization and would be expected to have similar binding properties.

Applicants have amended claim 1 to exclude nucleic acids which hybridize under stringent conditions with a complement sequence to SEQ ID NO:1 and encode a polypeptide which binds to IGF-1 receptor. Therefore, claim 1 is limited to isolated nucleic acids encoding a protein IIP-1 which binds to an IGF-1 receptor, wherein the nucleic acid is either a) SEQ ID NO: 1, or b) a nucleic acid that, due to the degeneracy of the genetic code, encode a IIP-1 polypeptide having the amino acid sequence of the polypeptide encoded by the sequence of SEQ ID NO:1.

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For this reason, Applicants submit that the polynucleotides disclosed by Rousset and DeVries, being 83% and 93.1% homologous, respectively, to SEQ ID NO:1, are not either a) SEQ ID NO: 1, or b) a nucleic acid that, due to the degeneracy of the genetic code, encode a IIP-1 polypeptide having the amino acid sequence of the polypeptide encoded by the sequence of SEQ ID NO:1. Therefore, Applicants respectfully requests reconsideration and withdrawal of the rejection of claims 1, 3, 5 and 6 as being anticipated under 35 USC § 102(b).

Allowable Subject Matter

Applicants thank Examiner Andres for her indication of allowable subject matter in claim 4, stating that the claim would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Because it is Applicants' position that claim 1, as amended, is now allowable, claim 4 should be allowable for that reason as well as the additional recitations it contains.

Conclusion

In summary, Applicants respectfully submit that the instant application is in condition for allowance. Early notice to that end is earnestly solicited.

If a telephone conference would be of assistance in furthering prosecution of the subject application, applicants request that the undersigned be contacted at the number below.

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No further fee is required in connection with the filing of this Amendment. If any additional fees are deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



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Enclosed : Request for a two-month extension of time

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